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07/714,441 06/13/91 BURTON

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EXAMINER

DAUS, D

ART UNIT

PAPER NUMBER

1202

DATE MAILED: 05/07/92

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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 10 Feb 92 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____  |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1, 5, 7-24, 32-41, 43 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 1, 8-24, 32-41 are rejected.

5. ☒ Claims 5, 7, 43 are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit 1202

Claims 1, 5, 7-24, 32-41 and 43 are in the case. Note claims 15, 16 appear duplicates.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is advised the patent file remains unlocatable.

Claims 9, 11-14, 18-20, 24, 3-34, 38-41 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Prior reasons 1, 2, 7, 8 and 10-11 are repeated and incorporated by reference; 1, 2 (claims 9, 11 to 14). Hydroxyl substitution is retained in the noted claims; 7, 8. Is "aryl" anthracene, perylene, etc. intended? Is Benzopyrene? (Its a carcinogen), "Aryl" is non-limiting as to number and configuration of rings. If the queried aryls are intended, its not apparent why their sources aren't provided; 10, 11. As drafted, reasons 10, 11 applied to claim 9 (number inadvertently left out of typed action) as well as claim 1. Amendment to claim 1 doesn't apply to overcome rejection of claim 9.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit 1202

Claims 1, 8 and 9 are rejected under 35 U.S.C. § 102(b and g) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Shepard '506.

Prior rejection is incorporated.

Applicants urges Lalu as rendering the reference less suggestive. In Lalu there was only utility as intermediate, Shepard generically teaches use, besides, intermediate, as antioxidant (col. 1, lines 30-33) clearly intended "organic material". Further Lalu is inconsistent with In re Magerlein 202 USPQ 473. Compositions with formula VI are contemplated by Shepard. The Baranauckas decision (108 USPQ 226) is very pertinent, that suggestion of halo, and exemplification of the adjacent halo, chloro, constituted an anticipation by narrow class. Shepard does teach antioxidant and other uses in lube oil, clearly an organic compositions.

Unlike Baranankas, Shepard discloses the same use.

Applicants read Shepard as excluding use in stabilizing organics. Col. 1 lines 14-26 disclose a genus overlapping VI, wherein the P substituted is halo or hydroxyl as "thus invention". Col. 1, line 30 states "phosphates of this invention may be used an [sic, in] antioxidants ..." (emphasis added).

Claim 8 is rejected under 35 U.S.C. § 102(b and g) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Baranauck~~as~~ et al.

Art Unit 1202

Prior rejection is incorporated <sup>by</sup> reference, claim 8 is to a resin (organic material) containing a minor proportion of a halogenated compound. F is one quarter (of the halogen) of that claim, and like Baranauka's the halo adjacent to that exemplified. The claim 9 range embraces those instantly recited (in dependent claims).

The Gatto declaration has been considered. The conclusion is that chloro analogs are too unstable for "polymers" as antioxidant. Claims 8+ aren't limited to polymers; showing isn't commensurate. Reference teaches same/similar range in resin (polymer).

Applicants urge reference discloses 5-15%, but claim 9 is to 0.2 to 13%. Moreover, instant claim 8 recites no range. It appears logically inconsistent to urge reference claims be limited to examples, while presenting a claim of 8's scope.

With respect to urged non-enablement, many of the journal references applicant provided are relied ~~to~~ provided enablement. In re Samour, 197 USPQ 1.

Claim 8 is rejected under 35 U.S.C. § 102(b and g) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Spivak '207.

Prior rejection is incorporated.

Claim 11 therein is to oxidative stabilizers for organic polymers, (a part of organic material). It is narrower in that

Art Unit 1202

aspect, while broader in that all halogens are embraced. It appears inconsistent ~~of~~ <sup>to</sup> urge Spivak be read as limited to disclosure, examples, While urging claim 8 scope.

Applicants rely on Taborsky's reference limited definitions, as some how beign ~~of~~ <sup>in</sup> Spivak's col. 3, lines 65-6 uses "such as" which is not a term of limitation. Taborsky is less controlling than Baranauckas.

Claims 8-23, 32-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 4,867,907. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim compositions are intended to be mixed/sprayed into organic compositions.

Instant specification paragraph bridging pages 3-14, admit the mixing and spraying operations are well known.

Patented compositions are closer to 1 or 8 than instant claim 1 is to instant claims 8+.

Brdat was based on his having filed before Public Law 98-627 (1984) provided relief (permitting all claims in a single application).

Borah, like Brdat involved mechanical combinations and Kaplan involved process conditions, not involved herein. In re Christman 53 USPQ 634, In re Higgins 152 USPQ 103 are more in

Art Unit 1202

point.

Claims 1 and 8-9 admit/evidence that mixing/spraying are the same inventive concept. So also is the composition for spraying/mixing of 1907. Applicants urge water is not mentioned. But water is the cheapest "volatile solvent" and the only one not requiring solvent recovery.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claims 5, 7 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Serial No. 07/714,441


-7-

Art Unit 1202

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Daus whose telephone number is (703) 308-4720.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Daus:st  
May 06, 1992

  
DONALD G. DAUS  
EXAMINER  
GROUP ABT UNIT 122